

**I IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES
(Attorney Docket No. 14305US02)**

In the Application of:

Jeyhan Karaoguz, et al.

Serial No. 10/675,489

Filed: September 30, 2003

For: METHOD AND SYSTEM FOR
MEDIA EXCHANGE NETWORK
WITH SERVICE USER
INTERFACE

Examiner: Patrick A. Ryan

Group Art Unit: 2427

Confirmation No. 6006

***Electronically Filed on
August 24, 2010***

APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicants respectfully request that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1-34, 37-39, and 42-44 of the present application. The Applicants request a 3-month extension of time within which to respond. Thus, the period for response runs until September 19, 2010, which is five months from the April 19, 2010 Notice of Appeal.

REAL PARTY IN INTEREST
(37 C.F.R. § 41.37(c)(1)(i))

The real party in interest is Broadcom Corporation, a corporation organized under the laws of the state of California, having a place of business at 5300 California Avenue, Irvine, California 92617, which has acquired the entire right, title and interest in and to the invention, the application, and any and all patents to be obtained therefor, as set forth in the Assignment recorded at Reel 014244, Frame 0625 in the PTO Assignment Search room.

RELATED APPEALS AND INTERFERENCES
(37 C.F.R. § 41.37(c)(1)(ii))

The Applicants are not currently aware of any proceedings that may be related to, directly affect or be directly affected by, or have a bearing on the Board's decision in the present appeal.

STATUS OF THE CLAIMS
(37 C.F.R. § 41.37(c)(1)(iii))

The present application includes claims 1-34, 37-39, and 42-44, all of which stand rejected. Claims 35, 36, 40, 41, 45, and 46 were canceled without prejudice or disclaimer.¹ The Applicants identify claims 1-34, 37-39, and 42-44 as the claims that are being appealed. The text of the claims involved in this Appeal is provided in the Claims Appendix.

STATUS OF AMENDMENTS
(37 C.F.R. § 41.37(c)(1)(iv))

Subsequent to the final rejection of claims 1-34, 37-39, and 42-44 mailed March 2, 2010, the Applicants filed a Notice of Appeal and Pre-Appeal Brief Request for

¹ See December 1, 2009 Amendment.

Review.² A mere 11 days after the Applicants filed the Notice of Appeal and Pre-Appeal Brief Request for Review, a Notice of Panel Decision from Pre-Appeal Brief Review was mailed to the Applicants.³ The Notice of Panel Decision from Pre-Appeal Brief Review indicates that the application should proceed to the Board of Patent Appeals and Interferences.⁴

No claims were amended in response to the final rejection of claims 1-34.

SUMMARY OF CLAIMED SUBJECT MATTER
(37 C.F.R. § 41.37(c)(1)(v))

Independent claim 1 recites the following:

A method for providing information related to a broadcast television program,⁵ the method comprising:

generating, remotely⁶ from a user's home,⁷ an announcement;⁸

delivering said announcement along with the broadcast television program for display on a television screen within said home,⁹ wherein said user decides if and when said announcement should be received, wherein said user chooses when to view said announcement,¹⁰ wherein said announcement is displayed on said television screen,¹¹ said announcement is independent of media content that is being displayed on said

² See April 19, 2010 Notice of Appeal and Pre-Appeal Brief Request for Review.

³ See April 30, 2010 Notice of Panel Decision from Pre-Appeal Brief Review. **Notably**, the Panel consisted of only the **Examiner** of the present application, and the **Supervisory Patent Examiner** who signed the Final Office Action. That is, the Panel did not include any personnel removed from previous prosecution of the present application.

⁴ See *id.*

⁵ See present application at, for example, page 3, lines 2-12.

⁶ See *id.* at, for example, page 11, lines 17-22, Figure 1, ref. 106.

⁷ See *id.* at, for example, page 7, lines 23-27, Figure 1, ref. 102.

⁸ See *id.* at, for example, page 3, lines 3-4, page 9, line 27 to page 10, line 6, page 15, lines 25-29, page 16, lines 3-8, Figure 1, ref. 115.

⁹ See *id.* at, for example, page 3, lines 4-5.

¹⁰ See *id.* at, for example, page 13, lines 1-7, page 14, lines 28-29.

¹¹ See *id.* at, for example, page 12, lines 25-29.

television screen at the time of said announcement,¹² and said announcement is delivered based on a profile of said user;¹³ and

receiving an input from said user that corresponds to said delivered announcement.¹⁴

Independent claim 11 recites the following:

A machine-readable storage having stored thereon, a computer program having at least one code section for providing information related to a broadcast television program,¹⁵ the at least one code section being executable by a machine for causing the machine to perform steps¹⁶ comprising:

generating, remotely¹⁷ from a user's home,¹⁸ an announcement;¹⁹

delivering said announcement along with the broadcast television program for display on a television screen within said home,²⁰ wherein said user decides if and when said announcement should be received,²¹ wherein said user chooses when to view said announcement,²² wherein said announcement is displayed on said television screen,²³ said announcement is independent of media content that is being displayed on said television screen at the time of said announcement,²⁴ and said announcement is delivered based on a profile of said user;²⁵ and

¹² See *id.* at, for example, page 9, line 27 to page 10, line 6, page 14, lines 17-18.

¹³ See *id.* at, for example, page 9, lines 18-20.

¹⁴ See *id.* at, for example, page 3, lines 5-7.

¹⁵ See *id.* at, for example, page 3, lines 20-24.

¹⁶ See *id.* at, for example, page 3, lines 22-24.

¹⁷ See *id.* at, for example, page 11, lines 17-22, Figure 1, ref. 106.

¹⁸ See *id.* at, for example, page 7, lines 23-27, Figure 1, ref. 102.

¹⁹ See *id.* at, for example, page 3, lines 3-4, page 9, line 27 to page 10, line 6, page 15, lines 25-29, page 16, lines 3-8, Figure 1, ref. 115.

²⁰ See *id.* at, for example, page 3, lines 4-5.

²¹ See *id.* at, for example, page 13, lines 1-7, page 14, lines 28-29.

²² See *id.* at, for example, page 13, lines 1-7, page 14, lines 28-29.

²³ See *id.* at, for example, page 12, lines 25-29.

²⁴ See *id.* at, for example, page 9, line 27 to page 10, line 6, page 14, lines 17-18.

²⁵ See *id.* at, for example, page 9, lines 18-20.

receiving an input from said user that corresponds to said delivered announcement.²⁶

Independent claim 21 recites the following:

A system for providing information related to a broadcast television program,²⁷ the system comprising:

at least one processor²⁸ that generates, remotely²⁹ from a user's home,³⁰ an announcement;³¹

said at least one processor delivers said announcement along with the broadcast television program for display on a television screen within said home,³² wherein said user decides if and when said announcement should be received,³³ wherein said user chooses when to view said announcement,³⁴ wherein said announcement is displayed on said television screen,³⁵ said announcement is independent of media content that is being displayed on said television screen at the time of said announcement,³⁶ and said announcement is delivered based on a profile of said user;³⁷ and

said at least one processor receives an input from said user that corresponds to said delivered announcement.³⁸

²⁶ See *id.* at, for example, page 3, lines 5-7.

²⁷ See *id.* at, for example, page 3, line 25 to page 4, line 11.

²⁸ See *id.* at, for example, page 11, line 23 to page 12, line 2, Figure 1, ref. 113.

²⁹ See *id.* at, for example, page 11, lines 17-22, Figure 1, ref. 106.

³⁰ See *id.* at, for example, page 7, lines 23-27, Figure 1, ref. 102.

³¹ See *id.* at, for example, page 3, lines 3-4, page 9, line 27 to page 10, line 6, page 15, lines 25-29, page 16, lines 3-8, Figure 1, ref. 115.

³² See *id.* at, for example, page 3, line 27 to page 4, line 1.

³³ See *id.* at, for example, page 13, lines 1-7, page 14, lines 28-29.

³⁴ See *id.* at, for example, page 13, lines 1-7, page 14, lines 28-29.

³⁵ See *id.* at, for example, page 12, lines 25-29.

³⁶ See *id.* at, for example, page 9, line 27 to page 10, line 6, page 14, lines 17-18.

³⁷ See *id.* at, for example, page 9, lines 18-20.

³⁸ See *id.* at, for example, page 4, lines 4-6.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL
(37 C.F.R. § 41.37(c)(1)(vi))

- Claims 1-32, 34, 37, 39, 42, and 44 stand rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,668,278 (“Yen”).
- Claims 33, 38, and 43 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Yen in view of U.S. 6,839,072 (“Trajkovic”).

ARGUMENT
(37 C.F.R. § 41.37(c)(1)(vii))

I. Yen Does Not Anticipate Claims 1-32, 34, 37, 39, And 42

The Applicants first turn to the rejection of claims 1-32, 34, 37, 39, and 42 as being anticipated by Yen. “A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in **a single prior art reference**.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). “The **identical** invention must be shown in as complete detail as is contained in ... the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).”

With those basic principles in mind, the Applicants turn to the specific claim language.

A. Claim 1 And The Claims That Depend Therefrom

Claim 1 recites, in part, “**wherein said user decides if and when said announcement should be received, wherein said user chooses when to view said announcement**.” As explained below, Yen does not describe, teach, or suggest all of these limitations.

Yen “relates to techniques for presenting broadcast and other information.” See Yen at column 1, lines 10-12. The system of Yen includes a “background” element, which interacts with interactive information sources and receives from passive information sources, and determines whether information from those sources is likely to be interesting to the recipient.” See *id.* at column 3, lines 16-21.

“The background filters and preferably prioritizes the information sources in response to the recipient preferences (**whether explicitly stated by the recipient or deduced in response to the recipient’s viewing habits or other information about the recipient**).” See *id.* at column 3, lines 54-58 (emphasis added).

Based on such information, the “background element 111 can determine the likely degree of interest the recipient will have in each information item, and so determine whether to transmit those information items to the foreground element 112.” *See id.* at column 9, lines 30-33.

The background element of an information multiplexor “records a set of preferences for the recipient, indicating the types of information the recipient is likely to be interested.” *See id.* at column 9, lines 53-56.

Yen also discloses responsive alert thresholds. In particular, Yen discloses the following:

In a preferred embodiment, the **alert threshold** (or the alert criteria) is responsive to at least one of the following:

Being set **explicitly by the recipient**. The recipient can specify separate threshold responsive to preference factors and exogenous factors described just below. Where the recipient has specified interest in particular classes or particular periodic information items, the recipient can specify an alert threshold for interrupting those items.

* * *

Being set **implicitly responsive to exogenous factors, including the day of the week, a time of day, or a number of recipients present for viewing the alerted item, or a particular information item currently being viewed by the recipient**.

See id. at column 12, lines 7-31 (emphasis added). As noted, the exogenous factors relate to **viewing** the alerted item, but there is nothing in Yen that describes that a user determines if and when an announcement is **received**, in contrast to being viewed.

The “alert threshold” merely “indicat[es] a degree of interest which is required from the background element 121 to alert the foreground element 122.” *See id.* at column 11, lines 59-61.

Thus, Yen notes that the recipient may explicitly set the threshold responsive to certain factors. Yen also notes that the alert threshold may be **implicitly** responsive

(that is, **not** set explicitly by the recipient). However, as noted, Yen does not describe, teach, or suggest that a user decides **if and when** the alert should be received, in addition to choosing when to actually view the alert.

Yen does not describe, teach or suggest that **a user decides if and when an alert** should be **received, and when to view the alert**. That is, Yen does not describe, teach or suggest “**wherein said user decides [1] if and when said announcement should be received, [and 2] wherein said user chooses when to view said announcement,**” as recited in claim 1.

In response, the Office Action cites to Yen at column 12, lines 7-11 and 27-31. See March 2, 2010 Office Action at page 3. The Applicants have reproduced Yen at column 12, lines 7-31 above.

The Applicants reiterate that claim 1 recites, “**wherein said user decides [1] if and when said announcement should be received, [and 2] wherein said user chooses when to view said announcement.**” The cited portions of Yen do not describe, teach, or suggest that a **user**: (1) decides **if and when** an announcement should be **received, and** (2) chooses **when to view** the announcement. Indeed, Yen simply does not describe, teach, or suggest all of these limitations of claim 1.

Accordingly, Yen, by itself, does not disclose “each and every element as set forth in the claim.” See *Verdegaal Bros.*, 814 F.2d at 631, 2 USPQ2d at 1053. Yen does not show the “**identical** invention ... in as completed detail as contained ... in the claim.” See *Richardson*, 868 F.2d at 1226, 9 USPQ2d at 1920 (emphasis added). Thus, for at least the reasons set forth above, Yen does not anticipate claim 1 or any of the claims depending therefrom.

B. Claim 11 And The Claims That Depend Therefrom

Claim 11 recites, in part, “wherein said **user decides if and when** said announcement should be received, wherein said **user chooses when to view said announcement.**” As explained above, Yen does not describe, teach, or suggest all of these limitations. Thus, for at least the reasons discussed above, Yen does not

anticipate claim 11 or the claims that depend therefrom.

C. Claim 21 And The Claims That Depend Therefrom

Claim 21 recites, in part, “wherein said **user decides if and when** said announcement should be received, wherein said **user chooses when to view said announcement.**” As explained above, Yen does not describe, teach, or suggest all of these limitations. Thus, for at least the reasons discussed above, Yen does not anticipate claim 21 or the claims that depend therefrom.

Additionally, with respect to claim 21, the Office Action refers to “Shoff” in its analysis. See March 2, 2010 Office Action at page 9. However, the Office Action does not make clear that the claims are rejected as being anticipated by “Shoff,” or the exact identity of such reference. The Applicants assume that reference to “Shoff” is merely a typographical error.

II. The Proposed Combination Of Yen And Trajkovic Does Not Render Claims 33, 38, And 43 Unpatentable

The Applicants now turn to the rejection of claims 33, 38, and 43 as being unpatentable over Yen in view of Trajkovic. In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (“MPEP”) states the following:

The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that “rejections on obviousness **cannot be sustained with mere conclusory statements**; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

See MPEP at § 2142, citing *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d at 1396 (quoting Federal Circuit statement with approval (emphasis added)).

Further, as specifically noted in the Manual of Patent Examining Procedure, “[t]o establish *prima facie* obviousness of a claimed invention, **all** the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” See MPEP at 2143.03 (emphasis added). Further, “[**a**ll words in a claim **must be considered** in judging the patentability of that claim against the prior art.’ *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA).” See *id.* (emphasis added).

For at least the reasons discussed above with respect to claims 1, 11, and 21, the Applicants respectfully submit that the proposed combination of Yen and Trajkovic does not render claims 33, 38, and 43 unpatentable.

III. CONCLUSION

For at least the reasons discussed above, the Applicants respectfully submit that the pending claims are allowable. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1-34, 37-39, and 42-44.

IV. PAYMENT OF FEES

The Commissioner is authorized to charge any necessary fees, including the \$1110 fee for the 3-month extension and the \$540 fee for this Appeal Brief, or credit overpayment to Deposit Account 13-0017.

Respectfully submitted,

Dated: August 24, 2010

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CLAIMS APPENDIX
(37 C.F.R. § 41.37(c)(1)(viii))

1. A method for providing information related to a broadcast television program, the method comprising:

generating, remotely from a user's home, an announcement;

delivering said announcement along with the broadcast television program for display on a television screen within said home, wherein said user decides if and when said announcement should be received, wherein said user chooses when to view said announcement, wherein said announcement is displayed on said television screen, said announcement is independent of media content that is being displayed on said television screen at the time of said announcement, and said announcement is delivered based on a profile of said user; and

receiving an input from said user that corresponds to said delivered announcement.

2. The method according to claim 1, wherein said announcement comprises one or more of a service announcement, a media announcement, and/or a data announcement.

3. The method according to claim 1, comprising determining whether said received input one of accepts or rejects said delivered announcement.

4. The method according to claim 3, comprising if said received input selection accepts said delivered announcement, transferring media associated with said delivered announcement for display on said television screen.

5. The method according to claim 4, comprising transferring said media concurrently with viewing of the broadcast television program.

6. The method according to claim 1, comprising if said received input comprises an acceptance of said delivered announcement and said delivered announcement comprises a service announcement, delivering service information related to said service announcement to said user within said home.

7. The method according to claim 1, wherein said input is generated from one or more of a remote control, a keyboard, a scanning device, and/or an audio processing device.

8. The method according to claim 1, comprising generating supplemental information related to said announcement in response to said received input.

9. The method according to claim 8, comprising presenting said supplemental information to said user.

10. The method according to claim 8, comprising presenting on said television screen, said supplemental information to said user concurrently with the broadcast television program.

11. A machine-readable storage having stored thereon, a computer program having at least one code section for providing information related to a broadcast television program, the at least one code section being executable by a machine for causing the machine to perform steps comprising:

generating, remotely from a user's home, an announcement;

delivering said announcement along with the broadcast television program for display on a television screen within said home, wherein said user decides if and when said announcement should be received, wherein said user chooses when to view said announcement, wherein said announcement is displayed on said television screen, said announcement is independent of media content that is being displayed on said television screen at the time of said announcement, and said announcement is

delivered based on a profile of said user; and

receiving an input from said user that corresponds to said delivered announcement.

12. The machine-readable storage according to claim 11, wherein said announcement comprises one or more of a service announcement, a media announcement, and/or a data announcement.

13. The machine-readable storage according to claim 11, comprising code for determining whether said received input one of accepts or rejects said delivered announcement.

14. The machine-readable storage according to claim 13, comprising code for transferring media associated with said delivered announcement for display on said television screen, if said received input selection accepts said delivered announcement.

15. The machine-readable storage according to claim 14, comprising code for transferring said media concurrently with viewing of the broadcast television program.

16. The machine-readable storage according to claim 11, comprising code for delivering service information related to said service announcement to said user within said home, if said received input comprises an acceptance of said delivered announcement and said delivered announcement comprises a service announcement.

17. The machine-readable storage according to claim 11, wherein said input is generated from one or more of a remote control, a keyboard, a scanning device, and/or an audio processing device.

18. The machine-readable storage according to claim 11, comprising code for generating supplemental information related to said announcement in response to said received input.

19. The machine-readable storage according to claim 18, comprising code that causes said supplemental information to be presented to said user.

20. The machine-readable storage according to claim 18, comprising code for presenting on said television screen, said supplemental information to said user concurrently with the broadcast television program.

21. A system for providing information related to a broadcast television program, the system comprising:

at least one processor that generates, remotely from a user's home, an announcement;

said at least one processor delivers said announcement along with the broadcast television program for display on a television screen within said home, wherein said user decides if and when said announcement should be received, wherein said user chooses when to view said announcement, wherein said announcement is displayed on said television screen, said announcement is independent of media content that is being displayed on said television screen at the time of said announcement, and said announcement is delivered based on a profile of said user; and

said at least one processor receives an input from said user that corresponds to said delivered announcement.

22. The system according to claim 21, wherein said announcement comprises one or more of a service announcement, a media announcement, and/or a data announcement.

23. The system according to claim 21, wherein said at least one processor determines whether said received input one of accepts or rejects said delivered announcement.

24. The system according to claim 23, wherein said at least one processor transfers media associated with said delivered announcement for display on said television screen, if said received input selection accepts said delivered announcement.

25. The system according to claim 24, wherein said at least one processor transfers said media concurrently with viewing of the broadcast television program.

26. The system according to claim 21, comprising, if said received input selection comprises an acceptance of said delivered announcement and said delivered announcement comprises a service announcement, delivering service information related to said service announcement to said user within said home.

27. The system according to claim 21, wherein said input is generated from one or more of a remote control, a keyboard, a scanning device, and/or an audio processing device.

28. The system according to claim 21, wherein said at least one processor generates supplemental information related to said announcement in response to said received input.

29. The system according to claim 28, wherein said at least one processor presents said supplemental information to said user.

30. The system according to claim 28, said at least one processor presents on said television screen, said supplemental information to said user concurrently with the broadcast television program.

31. The system according to claim 21, wherein said at least one processor is one or more of a media processing system processor, a media management system processor, a computer processor, media exchange software processor, and/or a media peripheral processor.

32. The method according to claim 1, wherein said user profile is established by said user.

33. The method according to claim 1, wherein said user profile is a default user profile assigned to said user.

34. The method according to claim 1, comprising displaying said announcement based on interaction of said user.

37. The machine-readable storage according to claim 11, wherein said user profile is established by said user.

38. The machine-readable storage according to claim 11, wherein said user profile is a default user profile assigned to said user.

39. The machine-readable storage according to claim 11, comprising displaying said announcement based on interaction of said user.

42. The system according to claim 21, wherein said user profile is established by said user.

43. The system according to claim 21, wherein said user profile is a default user profile assigned to said user.

44. The system according to claim 21, comprising displaying said announcement based on interaction of said user.

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Appeal Brief

EVIDENCE APPENDIX
(37 C.F.R. § 41.37(c)(1)(ix))

- (1) U.S. 6,668,278 ("Yen"), entered into record by Examiner in September 2, 2009 Office Action.
- (2) U.S. 6,839,072 ("Trajkovic"), entered into record by Examiner in September 2, 2009 Office Action.

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RELATED PROCEEDINGS APPENDIX
(37 C.F.R. § 41.37(c)(1)(x))

The Applicants are unaware of any appeals or interferences related to the present application.